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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,574	11/28/2003	Allan Tanghoj	P66852US3	4958
136 7590 12/26/2007 JACOBSON HOLMAN PLLC 400 SEVENTH STREET N.W. SUITE 600 WASHINGTON, DC 20004			EXAMINER GILBERT, ANDREW M	
			ART UNIT 3767	PAPER NUMBER
			MAIL DATE 12/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/722,574

Applicant(s)

TANGHOJ ET AL.

Examiner

Andrew M. Gilbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 and 7-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/23/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/27/07; 11/27/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/9/2007 has been entered.

Acknowledgements

2. This office action is in response to the reply filed on 10/9/2007.
3. In the reply, the applicant amended claims 1, 14, and 19.
4. Claims 2-5, 7-11 remain withdrawn.
5. Thus, claims 1, 6, 12-20 are pending, with claims 1 and 19 being independent.

Information Disclosure Statement

6. The information disclosure statement (IDS) submitted on 6/27/07, 11/27/07 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 12, 13, 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Juster (3750875).

9. In reference to claims 1 and 19, Juster discloses a kit for preparing a catheter for draining a human bladder, the kit comprising at least a first proximal catheter section (13) and a second distal catheter section (15); said two catheter sections defining a longitudinally extending passage therein configured to received a flow of urine therethrough from a proximal end portion of said first catheter section to a distal end of said second catheter section, the sections being fixedly connected by a joint (see transition where 13 and 15 are attached along with 17; wherein the Examiner notes that Webster's defines "joint" as "a place where two things or parts are joined"; in the instant case, parts 11 and 15 are two distinct parts joined by the beveled transition. The Examiner recommends further structurally defining the joint to overcome the prior art of record) and arranged in a coextending fashion with a tubular protective member (21) surrounding said first catheter section, said second distal catheter section being not covered when said kit is configured for storage (Fig 1), the kit further including a joint defining a substantially liquid tight seal (the beveled joint joining 13 and 15 forms a substantially liquid tight frictional fit seal with the proximal end (25) of the tubular protective member (21)) at a distal end of a substantially annular and longitudinally extending cavity provided between the proximal end portion of the first catheter section and an inner wall of the tubular protective member (the beveled joint joining 13 and 15 forms a substantially liquid tight frictional fit seal with the proximal end (25) of the tubular

protective member (21); Fig 1), the tubular protective member being removably connected to the second catheter section (Fig 1-2), so that, when the tubular protective member is removed, said proximal end portion of the first catheter section is exposed and ready for insertion into the human urethra (Fig 1-2, col 1-2).

10. In reference to claim 12 and 20, Juster additionally discloses wherein the catheter has a hydrophilic surface and a liquid swelling medium is provided in the annular cavity (col 3, lns 35-55).

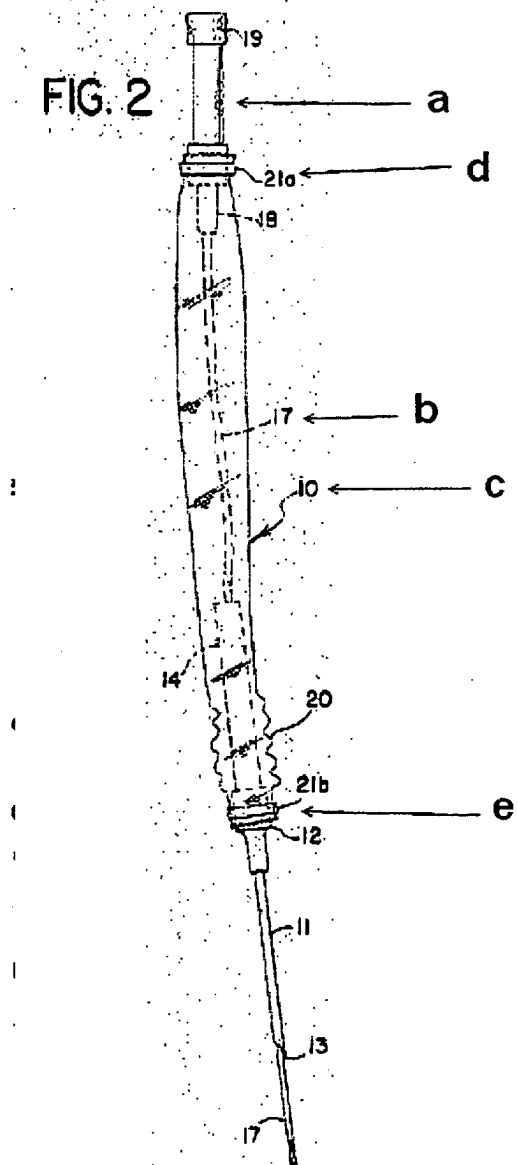
11. In reference to claim 13, Juster additionally discloses wherein the tubular protective member is detachably attached to an outer surface of the catheter when the tubular protective member is covering the first catheter section (Fig 1-2; the proximal end (25) forms a detachable frictional fit with outer surface of the beveled joint of the catheter than joins 13 and 15).

12. In reference to claim 18, Juster additionally discloses wherein the tubular protective member fastens to said second catheter section when the tubular protective member is covering the first catheter section (Fig 1-2; the proximal end (25) forms a detachable frictional fit with outer surface of the beveled joint of the catheter than joins 13 and 15).

13. Claims 1, 6, 13-14, 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by L. F. Waldman, Jr., hereafter "Waldman", (3335723).

14. In reference to claims 1 and 19, Waldman discloses a kit for preparing a catheter for draining a human bladder, the kit comprising at least a first proximal catheter section

(b; See annotated Figure 2 below) and a second distal catheter section (a); said two catheter sections defining a longitudinally extending passage therein configured to received a flow of urine therethrough from a proximal end portion of said first catheter section to a distal end of said second catheter section, the sections being fixedly connected by a joint (d) and arranged in a coextending fashion with a tubular protective member (c) surrounding said first catheter section, said second distal catheter section being not covered when said kit is configured for storage, the kit further including a joint defining a substantially liquid tight seal (d; col 2) at a distal end of a substantially annular and longitudinally extending cavity provided between the proximal end portion of the first catheter section and an inner wall of the tubular protective member (a, d, c; Fig 2), the tubular protective member being removably connected to the second catheter section (c), so that, when the tubular protective member is removed, said proximal end portion of the first catheter section is exposed and ready for insertion into the human urethra (Figs 1-3; a-e; col 2; wherein the seals are fully capable of being removed as they may be rubber bands or plastic tape; where the Examiner suggests further structurally defining the removing process and/or the structure of the joint and detachable seals to overcome the prior art of record).



Annotated Figure 2: Waldman.

15. In reference to claim 6, Waldman discloses wherein a distal end of the second catheter section is provided with a removable liquid-tight seal (d; discussion above).

16. In reference to claim 13, Waldman additionally discloses wherein the tubular protective member is detachably attached to an outer surface of the catheter when the tubular protective member is covering the first catheter section (d; discussion above).

17. In reference to claim 14, Waldman additionally discloses wherein said tubular protective member includes an outward flange at a distal end thereof (e).

18. In reference to claim 16, Waldman additionally discloses a ribbed portion between said first and second sections (18, 21a; d).

19. In reference to claim 17, Waldman additionally discloses wherein said tubular protective member fastens to said second catheter section through engagement with said ribbed portion (a, b, d; col 2).

20. In reference to claim 18, Waldman additionally discloses wherein the tubular protective member fastens to said second catheter section when the tubular protective member is covering the first catheter section (a-d; col 2).

Double Patenting

21. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

22. Claims 1, 6, 12-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26, 54-65 of copending Application No. 10/184081 or claims 1-21 of copending Application No. 10/537014. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the present application are merely broader than the copending parent case. Thus, the invention claimed in the current application is merely generic to the species claimed in the parent application and it has been held that the generic invention is anticipated by the species.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

23. Applicant's arguments with respect to claims 1, 6, 12-20 have been considered but are moot in view of the new ground(s) of rejection.

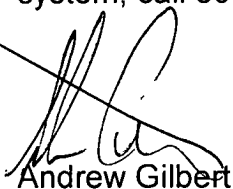
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571) 272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Gilbert

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

